

REMARKS/ARGUMENTS

The Applicants respectfully request reconsideration of the present Application in view of the foregoing amendments and the following remarks/arguments. Claims 1-25 were originally filed in the present Application. By Preliminary Amendment, claims 2, 4, 5, 9, 19 and 20 were canceled, without prejudice or disclaimer, claims 26-48 were added, and claims 1, 3, 6-8, 10-18 and 23-25 were amended. By the present Amendment, Applicants have amended claims 1, 3 and 8, and have canceled claim 10. In addition, Applicants have withdrawn claims 6, 12, 14-18 and 21-48 in response to the Examiner's Restriction Requirement. Accordingly, claims 1, 3, 7, 8, 11 and 13 are pending and presently under consideration in the present Application. No new matter has been added.

I. OBJECTIONS AND FORMAL MATTERS

The Examiner has made a Restriction Requirement for the claims into Group I (claims 1, 3, 6-8, 10-17 and 29-34), Group II (claims 18, 21-24 and 26-28, and Group III (claims 25 and 35-45). In addition, the Examiner has also made a Restriction Requirement for Species I (Figures 1-4), Species II (Figures 9 and 10), Species III (Figures 11 and 12), Species IV (Figures 13A and 13B), Species V (Figures 14A and 14B), Species VI (Figures 15A, 16 and 17), Species VII (Figures 15B), and Species VIII (Figures 18A-18F). Applicants provisionally elected to prosecute Group I of the claims, and Species VI of the drawings, and hereby formally make such election. As a result, the pending Office Action and the present Amendment are directed to claims 1, 3, 7, 8, 11 and 13, and the embodiments illustrated in Figures 15A, 16 and 17 of the drawings.

The Examiner has objected to the drawings on various grounds. First, the Examiner

objects to reference number “200” being used to describe the embodiments in both Figure 15A and Figure 15B. In response, Applicants have amended the drawings and the specification to use distinct designators (i.e., 200A and 200B, respectively) for these two figures, and thus respectfully request that the Examiner withdraw the objection. Likewise, the Examiner has objected to reference number “216” being used to describe the openings in the embodiments in Figure 15A and Figure 15B. In response, Applicants have amended the drawings and the specification to use distinct designators (i.e., 216A and 216B, respectively) for these two openings, and thus respectfully request that the Examiner withdraw this objection as well.

The Examiner has also objected to the drawings because reference number “218” in Figure 15B does not point to a flat surface, but rather to an edge of opening 216. Applicants have amended Figure 15B to better illustrate the features that numbers 218 and 220 identify. In addition, the Examiner has objected to Figure 15B for not correctly illustrating a cross section of Figure 15A. In response, Applicants have amended Figure 15A to include Line 15B-15B (where the cross section view has been taken), have amended Figure 15B to include the desired hatch marks, and have amended the specification to indicate that Figure 15B is a cross section view of Figure 15A taken along Line 15B-15B, but with a different embodiment of the opening illustrated in Figure 15A. In view of these amendments, Applicants respectfully request that these objections also be withdrawn.

The Examiner has also objected to the specification for failing to provide proper antecedent basis for the “first engaging surface” and the “mating surface” recited in the claims, as well as the use of the single designator number “15” to discuss Figures 15A and 15B. In response, Applicants have amended the specification in the appropriate places to include a clearer description of the claimed subject matter intended to be covered by the specification.

Accordingly, Applicants respectfully request that these objections to the specification also be withdrawn.

Furthermore, an Examiner Interview between the Examiner and the prior Attorney for Applicants, Diana Rea, took place on December 1, 2004. In that Interview, the cited Rapata reference (U.S. Patent 3,539,234) was discussed, as well as proposed amendments to the then-pending claims. The Examiner issued an Interview Summary (Form PTOL-413) setting forth an official record of the Interview, and that no agreement could be reached at that time. Because no agreement could be reached, Applicants did not file the proposed claim amendments in this Application. Moreover, Applicants have no objection to the Interview Summary prepared by the Examiner.

II. REJECTIONS UNDER 35 U.S.C. §112

The Examiner has rejected independent claim 1 under 35 U.S.C. §112, second paragraph, as allegedly failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Specifically, the Examiner states that the use of the term “maximum diameter” in claim 1 is a relative term, and therefore indefinite without referencing a feature with which to compare this diameter. While the Applicants do not necessarily agree with the Examiner’s position, the Applicants have amended claim 1 to remove this limitation, since it unnecessarily limits the scope of the claims. Since the limitation at issue has been removed, Applicants respectfully request that the rejection of claim 1 and its dependent claims under §112, second paragraph, be withdrawn.

III. REJECTIONS UNDER 35 U.S.C. §102

The Examiner has rejected independent claim 1 and its dependent claims under 35 U.S.C.

§102(b) as allegedly anticipated by U.S. Patent No. 3,539,234 to Rapata. The Applicants respectfully assert that independent claim 1 and its dependent claims are not anticipated by Rapata, since Rapata does not disclose each and every element recited in claim 1, as amended.

In the Office Action, the Examiner states that components “adapted to” perform a function are not typically given patentable weight, so long as the cited reference is capable of performing the specified function. However, the device in Rapata that is cited by the Examiner is not capable of performing in the same manner as the claimed structure in the present Application. While at first glance, the device in Rapata may appear to be capable of fastening two separate pieces together as recited in the present claims, it cannot perform that function without preventing the device from performing its own intended function.

As stated in M.P.E.P. 2112 (III), a rejection under 35 U.S.C. §102 may be proper when the rejected claims recite a structure in terms of a function, if the prior art device may be viewed as having the same composition as the claimed structure, even if the prior art is silent as to the claimed function. However, in such situations, the Examiner must provide rationale or evidence tending to show that such function is inherent in the prior art device. M.P.E.P. 2112 (IV). As such, evidence that a certain result or function *may* result or be present in the prior art device is not sufficient to establish inherency. Thus, “[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill in the art.” *In Re Robertson*, 49 USPQ2d 1949 (Fed. Cir. 1999). As a result, the Applicants can rebut a *prima facie* rejection under §102 “by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product.” M.P.E.P. 2112.01 (I) (emphasis in the original).

With these points in mind, the Applicants respectfully assert that the device in Rapata cited by the Examiner does not inherently perform the function recited in the claims of the present Application. Specifically, claim 1 recites a plug fastener having a first engaging surface with an outermost diameter adapted to frictionally engage an interior surface of the opening in the picket, along with a mating surface having an outer diameter adapted to frictionally engage an interior surface of the second article, where the frictional engagement of the first engaging surface and the mating surface is sufficient to connect the picket to the second article. In contrast, the Rapata device is a bushing constructed with a spherical outer surface that engages the interior surface of a “workpiece aperture 32,” along with a central bore sized to receive a shaft. By receiving the shaft within the bushing, the device permits the shaft (e.g., stud member 40) to have “rotational and angular movement relative to the bore.” (See Abstract of Rapata). With this structure, the outer surface of the Rapata device could not be used to engage two separate openings to connect two parts together, since to do so would then block the shaft or stud member from being inserted within the bushing, as explicitly intended, designed and constructed.

In addition, even if the openings in one or both of the two parts extended all the way through the part(s) such that a shaft could reach the bushing, the bushing could not provide the “rotational and angular movement” to the shaft desired by Rapata because the shaft would contact the interior surfaces of the opening(s) when attempting to move it in the specified manner. Moreover, while the claimed fastener connects two separate pieces such that the two are solidly held together (e.g., for a handrail intended to support people), the Rapata device explicitly provides coupling a shaft to a workpiece such that the shaft is moveable with respect to the workpiece. Furthermore, even in those species/embodiments of the claimed invention(s) that are constructed so as to receive a screw through the fastener in order to secure the fastener

against one of the two separate pieces (e.g., the embodiment illustrated in Figure 15B), the Rapata device still does not inherently disclose the characteristics provided by the structure recited in claim 1. Specifically, since the Rapata device expressly intends that the shaft be received through the bushing to rotate and pivot with respect to the workpiece, the Rapata device could not receive a screw through its opening because to do so would obviate the express placement of the shaft in the opening. Thus, for this reason as well, it cannot be said that Rapata provides a fastener having a structure that is capable of providing the function of the structure recited in claim 1 and its dependent claims.

For at least these reasons, it is clear that while the Rapata device may appear to have a structure similar to the device recited in present claim, the characteristics provided by the claimed structure are not inherent in the Rapata device. As a result, Rapata does not disclose all of the elements of independent claim 1, and the Applicants respectfully request that the Examiner provide sufficient evidence that the Rapata device can inherently perform the function provided by the claimed structure in the present Application. Accordingly, because the Applicants believe such evidence does not exist, it is respectfully requested that the Examiner withdraw the §102(b) rejection with respect to claims 1, 3, 7, 8, 11 and 13.

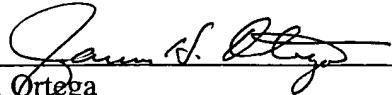
IV. CONCLUSION

The Applicants respectfully submit that pending claims 1, 3, 7, 8, 11 and 13 are in condition for allowance, and request a Notice of Allowability for the pending claims. The Examiner is invited to contact the undersigned Attorney of Record if such would expedite the prosecution of the present Application. Because the mailing date of the pending Office Action is December 17, 2004, the Applicants request a two-month extension of time to file the present Amendment before May 17, 2005. A check in the amount of \$450 is enclosed herewith to

accommodate the two month extension of time fee. If it is determined that additional fees are due, or an overcharge has occurred, please charge or credit Deposit Account No. 13-0480, referencing the Attorney Docket Number specified herein.

Respectfully submitted,

Date: May 13, 2005


James H. Ortega
Reg. No. 50,554
BAKER & MCKENZIE LLP
2300 Trammell Crow Center
2001 Ross Avenue
Dallas, TX 75201
Tel: (214) 978-3000
Fax: (214) 978-3099